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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,102	11/18/2003	Matthias Brunner	ZIMR/0005	6114

7590 11/16/2005

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EXAMINER

KARLSEN, ERNEST F

ART UNIT	PAPER NUMBER
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2829

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action SummaryApplication No. **10/716,102**

Applicant(s)

BRUNNER, MATTHIAS

Examiner

Ernest F. Karlsen

Art Unit

2829

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-20 and 22-53 is/are pending in the application.
4a) Of the above claim(s) 17-20 and 22-53 is/are withdrawn from consideration.
5) ☒ Claim(s) 6-16 is/are allowed.
6) ☐ Claim(s) _____ is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/03/05
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

New claim 53 submitted in the response of September 2, 2005 is grouped with Invention VI which is non-elected.

Applicant's election with traverse of Invention I, species 2, claims 6-16 in the reply filed on September 2, 2005 is acknowledged. The traversal is on the ground(s) that the inventions and species are not distinct with respect to restriction. This is not found persuasive because Applicants admit that the claims are patentably distinct and argue that the restriction is not proper due to the similarity in the claims. Applicants' amendments to claim 6 are not considered reason to require the withdrawal of the restriction between Inventions I and VI-VII. The method of claim 6 can presumably be practiced by any of the materially different devices of Inventions VI-VII. The restriction between Inventions II and III is considered proper for the reasons previously given. Applicants argue that one invention claims displacement range and the other invention claims contact unit size and the two features are related and so should be examined together. Admission on the record that the inventions are not patentably distinct will result in rejoining. Applicants further argue that Inventions V and VII should be examined together. It is noted that Invention V contained only claim 35 which has been amended so as to included in Invention II. The requirement to restrict of April 19, 2005 is considered proper.

Claim 35, because of the amendment of September 2, 2005, is placed in Invention II. Invention IV is no longer present because claim 21 has been cancelled.

The requirement is still deemed proper and is therefore made FINAL.

Claims 17-20 and 22-53 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions and/or species, there being no allowable generic or linking claim. Applicants timely traversed the restriction (election) requirement in the replies filed on May 23, 2005 and September 2, 2005.

The following is an examiner's statement of reasons for allowance: No reference was found anticipating or a combination of references found making obvious a method for testing a substrate with several test objects with a test apparatus having a holder for the substrate, a displacement unit for the holder with a holder displacement range in x-direction and a holder displacement range in y-direction and a contact unit for contacting of the at least one test object, whereby the contact unit has a displacement range in x-direction and/or in y-direction, and the contact unit displacement range in x-direction and/or the contact unit displacement range in y-direction are smaller than the respective holder displacement range, comprising the following steps: putting the substrate on the holder, contacting of a first test object with the contact unit wherein the contact unit has essentially maximal the dimension of half of the holder dimension in one direction perpendicular to the optical axis; positioning of the substrate so that a first area of the first test object lies in a test range of the test apparatus, testing of the first area of the test object, displacing the substrate so that at least a further area of the first test object lies in the test range of the test apparatus, displacing the contact unit so that the position of the contact unit is essentially unchanged with respect to the first test object, testing of the further area of the test object, and displacing the contact unit and the substrate relative to each other so that a further test object can be contacted.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Claims 6-16 are allowed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kawamura et al, Abe et al and Iwasaki et al are cited to show prior art apparatus wherein devices under test are positioned relative to a corpuscular beam.

This application is in condition for allowance except for the presence of claims 17-20 and 22-53 to an invention non-elected with traverse in the reply filed on May 23, 2005 and September 2, 2005. Applicant is given ONE MONTH or THIRTY DAYS from the date of this letter, whichever is longer, to cancel the noted claims or take other appropriate action (37 CFR 1.144). Failure to take action during this period will be treated as authorization to cancel the noted claims by Examiner's Amendment and pass the case to issue. Extensions of time under 37 CFR 1.136(a) will not be permitted since this application will be passed to issue.

The prosecution of this case is closed except for consideration of the above matter.

Any inquiry concerning this communication should be directed to Ernest F. Karlsen at telephone number 571-272-1961.

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Ernest F. Karlsen

November 14, 2005


ERNEST KARLSEN
PRIMARY EXAMINER